

REMARKS

Claims 1, 3-9, 11-16, and 18-24 are pending. In view of the following remarks, Applicant respectfully requests that the Examiner reconsider all outstanding rejections.

35 U.S.C. § 103 Rejection

Claims 1, 3-9, 11-16 and 18-24 stand rejected under 35 USC § 103(a) as being unpatentable over Goyal et al (5,873,108) in view of Jenson (5,570,109). Applicant respectfully traverses this rejection.

A. Governing Criteria

For rejections under 35 U.S.C. Section 103, the establishment of a *prima facie* case of obviousness requires that all the claim limitations must be taught or suggested by the prior art. MPEP § 2143.03 The establishment of a *prima facie* case of obviousness requires that the claimed combination cannot change the principle of operation of the primary reference or render the reference inoperable for its intended purpose. MPEP § 2143.03.

The Supreme Court set the standard for evaluating obviousness in its recent decision (*KSR International Co. v. Teleflex Inc. et al.* (550 U.S. 127 S. Ct. 1727 (2007))) to be “expansive and flexible” and “functional.” However, the standard is not controlling, rather, the various noted factors only “can” or “might” be indicative of obviousness based on the facts. The Supreme Court in *KSR* enunciated the following principles:

“[w]hen a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, Section 103 likely bars it patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill....[A] court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.

Simply using the benefit of hindsight in combining references is improper. *In re Lee*, 277 F.3d 1338, 1342-45 (Fed. Cir. 2002); *In re Deminski*, 796 F.2d 436, 442 (Fed. Cir. 1986)). The Supreme Court while recognizing the need “to guard against slipping into the use of hindsight,” acknowledged the following principles:

[r]ejection on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.

[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.

One of the ways in which a patent's subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent's claims.

Rather, obviousness is to be determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. See 35 U.S.C. § 103(a). The legal construct also presumes that all prior art references in the field of the invention are available to this hypothetical skilled artisan. *In re Carlson*, 983 F.2d 1032, 1038, 25 USPQ 2d 1207, 1211 (Fed. Cir. 1993). The Supreme Court in *KSR* stated that:

a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was independently, known in the prior art.

An examiner may often find every element of a claimed invention in the prior art. "Virtually all [inventions] are combinations of old elements." *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed.Cir. 1983), cert. denied, 464 U.S. 1043 (1984); see also *Richel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed.Cir. 1983). If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 U.S.P.Q.2d 1551, 1554 (Fed.Cir.1996). In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior

art references for combination in the manner claimed. The Supreme Court in *KSR* has also stated that:

[o]ften, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the market place.

Further, the Supreme Court states that:

The Court relied upon the corollary principle that when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious.

B. Discussion

Goyal and Jenson, alone or in combination, do not teach or suggest the present claims. In rejecting the claims, the Examiner states:

In response, all of the limitations which Applicant disputes as missing in the applied references, including the features newly added in the 3/9/09 amendment, have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the collective teachings of Goyal and/or Jenson based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the remarks and explanations given in the preceding sections of the present Office Action and in the prior Office Action, incorporated herein. Office Action, p. 11-12.

However, the Examiner does not provide logic and sound scientific reasoning, but rather provides a conclusory statement that “these features are known in the art, as evidenced by Jenson.” In concocting the obviousness combination, the Examiner states explicitly that Goyal does not teach each and every element of the claims, specifically setting and referencing data categories. The Examiner states:

Goyal does not explicitly disclose referencing a time of day profile that correlates clock time of day information and day of week information with data categories stored on said handheld computer, wherein at least one data category in said portable electronic device is associated with a block of time corresponding to two or more days of said week; setting a default category which differentiates between business and personal hours based upon the clock time of day, the day of the week, and the time of day profile that is used for accessing stored data in the handheld computer and for storing entered data in the handheld computer at that clock time of day based on the real-time clock, wherein the default data category includes a business category during business times in days and a personal category during personal times in day wherein the time of day profile correlates a

clock time with at least one of a personal data category and a business category.
Office Action, p. 3.

Goyal does not teach these elements because Goyal does not contemplate the use of or the manipulation of categories as claimed.

To remedy Goyal's deficiency, the Examiner submits that Jensen is the evidence that discloses "this feature." However, as stated in the previous response, Jensen does not disclose the use of categories or even contemplate the concept of data categories. In fact, the word category does not appear within Jensen's specification.

The Examiner cites Figure 4 as disclosing referencing a time of day profile that correlates clock time of day information and day of week information with data categories. However, none of the information is categorized, much less categorized that differentiates between personal and business hours. For this, the Examiner cites Figures 11A-11B as disclosing setting a default data category that differentiates between personal and business hours using personal and business categories. However, this does not disclose data categorization.

Figure 11a reveals a view of Aug. 5 that contain a "Call Bob" and "Staff meeting" events. Figure 11b reveals those same events in a 3-day view, Aug 4-6. Figure 11c reveals those same events in a view that shows all Thursdays because Aug. 5 is a Thursday. Figure 11d reveals a to-do list for Aug. 5 that contain the items "Buy milk," "Call Bill," and "Send check." Figure 11e reveals those items in a 3-day view, Aug. 4-6, similar to the 3-day view in Figure 11b. Figure 11f reveals those to-do items in a "Thursdays" view similar to Figure 11c. The citations provided by the Examiner, col. 12, lines 35-67, describe how the various views are selected. Nowhere in the cited figures or the specification is the concept of data categorization, such as personal and business categories, revealed, discussed, or even contemplated. Jensen cannot be cited and combined with Goyal, which the Examiner admits does not disclose data categorization, to arrive at elements in the present claims directed towards setting and referencing data categorization based on a time of day profile. Accordingly, it is difficult to understand how two references that do not contemplate data categorization can be combined to arrive at claims whose scope and elements are squarely directed towards the categorization of data along at least personal and business categories.

As such, the stated motivation to combine Goyal and Jensen has little relevance to the present claims. The Examiner states

It would have been obvious to one of ordinary skill in the art at the time of the invention to have include the features of Jensen within the system of Goyal with the motivation of providing an efficient, intuitive method and apparatus for controlling both a schedule and a to-do list on the screen of a pen-based computer system. Office Action, p. 4.

However, as stated above the claims are directed towards automated categorization of data based on a time of day profile. While some embodiments of the present invention may contain “both a schedule and a to-do list,” the stated motivation of an efficient and intuitive method to display the schedule and to-do list is somewhat irrelevant.

Furthermore, Goyal does not teach “determining a day of the week” as presently claimed. The Examiner cite, col. 7, lines 66 – col. 8, line 46, provides no disclosure relating to determining the week. For example, Goyal states

Rather than make a separate entry each week, a facility is provided to repeat a selected entry at intervals. When a “Ditto” button 315 is touched, a screen display such as the one of FIG. 9 is displayed. The user then selects a repeat interval. The user may also specify that the entry is to be repeated a given number of intervals, for example each month for the next three months. Col. 8, lines 2-10.

Goyal is not determining a day of the week, but rather is saving a time interval selected by the user. This is further evidence that Goyal’s relevance to the present claims is suspect. Goyal does not perform any automatic categorization of data. Goyal categorizes data using user-entered tags. A tag is not required and a default tag is not applied should one not be entered. See col. 4, line 32 – col. 5, line 5. Goyal’s method is part of the problem(s) the Applicant purports to solve. For example, Applicant discloses

The palmtop computer user can currently segregate some of these tasks by designating a category at the time of entry, and at the time of retrieval, selectively retrieve only certain categories. But, the additional steps involved in categorizing entries and data being retrieved is often too cumbersome to encourage the user to fully utilize the palmtop computer’s categorization features. Thus, entries are often left uncategorized and retrieval of data generally is done globally to retrieve all entries without bothering to look only for a particular category. As a result, the calendar viewed is typically filled with both personal and business appointments, all entries are generally viewed in the address book and a mixed business/personal to-do list is generally viewed. Identifying the data of interest can thus be encumbered with irrelevant data. Specification, pp. 2-3.

Thus, Applicant respectfully submits Goyal's use as a primary reference is defective.

As stated previously, Jensen does not cure Goyal's deficiencies. The Examiner's cites are to a drawing process of a calendar on a screen of a pen-based computer. For example, Jensen discloses, and the Examiner has cited,

FIG. 4 illustrates the process step 80 of FIG. 3A in greater detail. Process 80 begins at 114 and, in a step 116, the month and year is determined. The month and year can be provided by the real-time clock 26 of FIG. 1, or can be stored as defaults within RAM 16. Next, in a step 118, the month is drawn in the form of a small calendar selector icon and the selected days of the month from the array DAYLIST are drawn over the calendar selector in a step 120. Finally, a month controller and month overview button are drawn in a step 122, and the process 80 is completed at 124.

The drawing steps such as steps 118-122 can be implemented within the context of the aforementioned view system. The view system, in turn, preferably utilizes graphics software such as QUICKDRAW, developed by Apple Computer, Inc. of Cupertino, Calif. A description of the QUICKDRAW graphics software is found in the book *Inside Macintosh*, Volumes I, II, and III, by C. Rose et al., Addison-Wesley Publishing Company, Inc., July 1988. With such graphics software, a line can be drawn by simply specifying the coordinates of the beginning and the end of the line, a rectangle or "box" can be placed around objects by specifying the corner points of the box, text can be drawn to the screen by specifying font, size, and location, etc. Therefore, the use of such graphics software greatly simplifies the screen drawing process of the present invention.

FIG. 5 illustrates the "Draw Crib Notes Area" process step 82 of FIG. 3a. The process 82 begins at 126 and, in a step 128, crib notes for the current DAYLIST are retrieved from memory, such as RAM 16. Next, in a step 130, the crib notes are displayed within a crib note area of the screen 42. This may involve some cropping of the crib notes if the amount of information to be displayed is greater than the space available. The process 82 is then completed at 132.

FIG. 6 illustrates the "Draw Content AREATYPE" process step 84 of FIG. 3A. Col. 9, lines 32-67 (emphasis added).

The fact that Figure 4 is described as a drawing process is further evidence that nothing in this cite or in the balance of Jensen teaches or suggests the present claims. As such, Goyal and Jensen, alone and in combination, do not teach or suggest the claimed matter. On that basis, reconsideration and allowance is respectfully requested.

Conclusion

All of the stated grounds of rejection have been properly addressed. Applicant therefore respectfully requests that the Examiner reconsider the outstanding rejections. The Examiner is

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invited to telephone the undersigned representative if an interview might expedite allowance of this application.

Respectfully submitted,

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